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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
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EXAMINER				
PATEL, CHIRAG R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/724,137

**Applicant(s)**

SHUDO, TAKAO

**Examiner**

CHIRAG R. PATEL

**Art Unit**

2454

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

As per claims 1-3, 7-11 and 22, the recitation "multifunction printer" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-11, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuwata et al. –hereinafter Kuwata (US 2003/0072031).

As per claims 1 and 22, Kuwata discloses a multi-function peripheral capable of at least copying, scanning, or printing image data (Figure 3) and communicating with a management server, the multi-function peripheral comprising:

an image data input unit inputting image data; ([0047]; Figure 3: fax, digital camera, printer, scanner/copier)

an authentication information input unit inputting authentication information necessary for authenticating a user; ([0049])

an authentication information transmitter transmitting said input authentication information to said management server; ([0049])

an additional function list receiver receiving from said management server, in response to the transmission of said authentication information, additional function information for specifying an additional function that is registered in association with said user in an additional function list, the additional function list including at least one additional function executable by said management server; ([0050]; some buttons may be disabled or hidden, depending on user's login type; Figure 14)

an additional function selector for selecting a desired additional function from the additional function list; and ([0128]-[0135])

an instruction transmitter transmitting said additional function information ([0128]-[0133]) and said input image data to said management server. ([0046; scan job, where hardcopy is scanned to the proofing system])

As per claim 2, Kuwata discloses the multi-function peripheral according to claim 1, further comprising a display unit displaying said received additional function information. ([0050]; Figure 14)

As per claim 3, Kuwata discloses the multi-function peripheral according to claim 2, wherein said display unit includes a title display unit displaying a title of the additional function, and a detail information display unit displaying, in response to specification of said displayed title, detail information about the additional function. ([0050]; Figure 14)

As per claim 7, Kuwata discloses the multi-function peripheral according to claim 1, wherein said additional function list includes at least one of: a transmission process for transmitting said image data to other computer; ([0003]) a recording process for recording said image data in a recording medium; ([0065]) and an image process. ([0128]-[0135])

As per claim 8, Kuwata discloses the the multi-function peripheral according to claim 7, wherein said transmission process includes a transmission through an e-mail. ([0003])

As per claims 9, Kuwata discloses the multi-function peripheral according to claim 7, wherein said transmission process includes a file transfer process. ([0003])

As per claim 10, Kuwata discloses the multi-function peripheral according to claim 7, wherein said recording process stores said image data in a database. ([0065])

As per claim 11, Kuwata discloses the multi-function peripheral according to claim 7, wherein said image process is at least one process selected from: a tilt correction process; a noise elimination process; a color matching process; and a direction correction process in which direction of an image is determined and the image is rotated for correction. ([0133])

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata (US 2003/0072031) in view of Gitany- Alonso (US 2004/0003095).

As per claim 4, Kuwata discloses the multi-function peripheral according to claim 1, wherein said peripheral is capable of communicating with a plurality of management servers through a network, and further comprises a management server selector selecting one of said plurality of management servers. ([0043]; multiple servers to share the load; Figure 5) Kuwata fails to disclose a multi-function peripheral. Gitany – Alonso discloses a multi-function peripheral ([0010]; multi-function device) In reference to KSR International Co. v. Teleflex Inc., 550 U.S. -, 82 USPQ2d 1385 (2007), it would be obvious and yielded predictable results for one of ordinary skill in the art to substitute the fax, digital camera, PC, printer, or scanner/copier (Figure 3) with the multifunction device to achieve the predictable result of carrying out more than one task (printing copying, scanning, faxing) simultaneously.

As per claim 12, Kuwata discloses the multi-function peripheral according to claim 1. wherein said additional function list includes an image process to said image data, said peripheral further comprising:

a processed image data receiver receiving a processed image data that has been executed the image process from said management server; and ([0136])

an output unit outputting said received processed image data. ([0140])

Gitany- Alonso discloses a multi-function peripheral. ([0010])

As per claim 13, Kuwata / Gitany-Alonso disclose the multi-function peripheral apparatus according to claim 12. Kuwata discloses wherein said output unit is an image ([0140])forming apparatus forming an image in a recording medium. ([0065])

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata (US 2003/0072031) / Gitany- Alonso (US 2004/0003095) further in view of Delany (US 2002/0156879).

As per claim 5, Kuwata / Gitany-Alonso disclose the multi-function peripheral according to claim 4. Kuwata fails to disclose comprising a detector detecting each of said plurality of management servers. Delany discloses further comprising a detector detecting each of said plurality of management servers. ([0119]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to disclose a detector detecting each of said plurality of management servers in the disclosure of Kuwata. The motivation for doing do would have been to scale the access management systems. ([0119]).

As per claim 6, Kuwata / Gitany-Alonso / Delany disclose multi-function peripheral according to claim 5. Delany discloses further comprising wherein said detector includes a send unit sending a search request to said network for detecting



said plurality of management servers, and a response receiver receiving a response to said search request. ([0119])

Claims 14, 16-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata et al. –hereinafter Kuwata (US 2003/0072031) in view of Gitany- Alonso (US 2004/0003095)

As per claims 14 and 23, Kuwata discloses a management server capable of communicating with an a multi-function peripheral capable of at least copying, scanning or printing image data ([0010]; functionality of multifunction device) , comprising:

an additional function storage unit storing an additional function list associating identification information for identifying a user with an additional function executable by the management server; ([0049],[0050])

an authentication information receiver receiving authentication information necessary for authenticating the user ([0049])

an authentication unit determining if said received authentication information is true or not; an additional function transmitter extracting, when said received authentication information is determined to be true by said authentication unit, information of an additional function stored in the additional function list in association with identification information included in said authentication information, and

transmitting the additional function information ([0050]; some buttons may be disabled or viewed, depending on user's login type; Figure 14)

a processing execute unit executing, when receiving image data ([0046]; scan job, where hardcopy is scanned to the proofing system)) and said additional function information ([0128]-[0135]) in response to the transmission of said additional function information, ([0050]) a process to said received image data in accordance with the additional function specified by said received additional function information. ([0128]-[0135])

Kuwata fails to disclose authenticating the user from said multi-function peripheral; transmitting additional function to said image processing apparatus, and receiving image data and said additional function information from said multi-function peripheral. Gitany- Alonso discloses authenticating the user from said multi-function peripheral; transmitting additional function to said multi-function peripheral, and receiving image data and said additional function information from said multi-function peripheral. ([0010]; multi-function device) In reference to KSR International Co. v. Teleflex Inc., 550 U.S. -, 82 USPQ2d 1385 (2007), it would be obvious and yielded predictable results for one of ordinary skill in the art to substitute the fax, digital camera, PC, printer, or scanner/copier (Figure 3) with the multifunction device to achieve the predictable result of carrying out more than one task (printing copying, scanning, faxing) simultaneously.

As per claim 16, please see the discussion under claim 7 as similar logic applies.

As per claim 17, please see the discussion under claim 8 as similar logic applies.

As per claim 18, please see the discussion under claim 9 as similar logic applies.

As per claim 19, please see the discussion under claim 7 as similar logic applies.

As per claim 20, please see the discussion under claim 7 as similar logic applies.

As per claim 21, please see the discussion under claim 11 as similar logic applies.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delany et al. - hereinafter Kuwata (US 2003/0072031) / Gitany- Alonso (US 2004/0003095) further in view of Kumpf et al. – hereinafter Kumpf (US 6,839,755).

As per claim 15, Kuwata / Gitany-Alonso disclose the method of claim 14. Kuwata fails to disclose wherein said management server is capable of communicating with a plurality of multi-function peripherals through a network and further comprises a response transmitter transmitting, in response to receipt of a search request transmitted from each of said plurality of multi-function peripherals, a response to said search request to the multi-function peripherals that has transmitted said search request. Kumpf discloses a response transmitter transmitting, in response to receipt of a search request transmitted from each of said plurality of image processing apparatuses, a response to said search request to the image processing apparatus that has transmitted

said search request (Col 3 lines 34-59; Col 4 lines 21-46; multifunction peripheral) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Kuwata to disclose wherein said management server is capable of communicating with a plurality of multi-function peripherals through a network and further comprises a response transmitter transmitting, in response to receipt of a search request transmitted from each of said plurality of multi-function peripherals, a response to said search request to the multi-function peripherals that has transmitted said search request. The motivation for doing do would have been to discover peripheral servers that a peripheral specific software can utilize. (Col 2 lines 30-40)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 8:00AM to 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (571) 272-1915.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/C. R. P./  
Examiner, Art Unit 2454

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2454